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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,908	03/05/2002	William E. Elswick	30788-23	9185

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EXAMINER

DUNN, MISHAWN N

ART UNIT PAPER NUMBER

2621

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

/ <b>Office Action Summary</b>	Application No. 10/091,908	Applicant(s) ELSWICK ET AL.	
	Examiner Mishawn N. Dunn	Art Unit 2621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 05 March 2002.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 9-16 and 19-21 is/are rejected.
- 7) ☒ Claim(s) 7, 8, 17 and 18 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 05 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                                | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                       | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

1. Claims 1-6, 9-16, and 19-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawakami et al (US Pat. No. 5,867,626) in view of Wood et al. (US Pub. 2002/0057893).
2. Consider claim 1. Kawakami et al. teaches an apparatus for playing audio /video programs using a bank of networked audio/video players (col. 9, lines 2-5, fig. 1), said apparatus comprising: means for storing a first portion of an audio/video program on a first audio/video player in a bank of networked audio/video players; means for storing a

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second portion of the audio/video program on a second audio/video player in the bank of networked audio/video players (col. 9, lines 17-19; user can manually record a first portion on first player, then stop and record second portion on second player); and means for transferring the second portion of the audio/video program from the second audio/video player to the first audio/video player and causing the audio/video program to be played on the audio/video player (col. 9, lines 22-26).

Kawakami et al. does not specifically disclose a means for inputting an instruction to play the audio/video program in the first audio/video player.

However, Wood et al. teaches a means for inputting an instruction to play the audio/video program in the first audio/video player (pg. 8, para. 0082; fig. 4).

Therefore, it would have been obvious to one with ordinary skill in the art, at the time the invention was made to use, to provide a means for inputting an instruction to play the audio/video program, in order to allow the user to conveniently playback the program.

3. Consider claim 2. Kawakami et al. teaches an apparatus wherein the audio/video program is played sequentially on the first audio/video player (col. 9, lines 22-26; the user can record and reproduce the program sequentially).

4. Consider claim 3. Kawakami et al. teaches an apparatus wherein the first portion is substantially larger than the second portion (col. 9, lines 22-26; the user can choose to make the first portion larger than the second portion).

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5. Consider claim 4. Kawakami et al. teaches an apparatus wherein the first portion accounts for approximately 85 to 95% of the audio/video program (col. 9, lines 22-26; the user can choose to make the first portion 85-95% larger than the second portion).

6. Consider claim 5. Kawakami et al. teaches an apparatus wherein the second portion is contiguous with the first portion (col. 9, lines 22-26; the user can record the program so that the second portion follows the first portion).

7. Consider claim 6. Kawakami et al. teaches an apparatus further comprising means for causing content from the second portion to be integrated with content from the first portion to provide content for playing at a given point in time (col. 9, lines 22-26; the user can record the program so that the second portion is integrated with the first portion).

8. Consider claim 9. Kawakami et al. teaches an apparatus wherein the audio/video program comprises a work that includes synchronized audio and video and is played sequentially by the first audio/video player (col. 9, line 28 – col. 10, line 50).

9. Consider claim 10. Kawakami et al. teaches an apparatus further comprising means for storing a third portion of the audio/video program on a third audio/video player in the bank of networked audio/video players (col. 9, lines 17-19), and wherein also in response to the instruction input to play the audio/video program in the first audio/video player, the third portion of the audio/video program is transferred from the third audio/video player to the first audio/video player (col. 9, lines 22-26).

10. Claims 11-16 and 19-21 are rejected using similar reasoning as in the corresponding claims above.

***Allowable Subject Matter***

11. Claims 7, 8, 17, and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

12. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. US Pat. No. 6,950,966
- b. US Pat. No. 6,499,039
- c. US Pat. No. 6,078,989

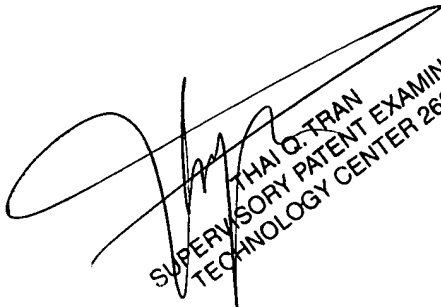
13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mishawn N. Dunn whose telephone number is 571-272-7635. The examiner can normally be reached on Monday - Friday 7:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thai Tran can be reached on 571-272-7382. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Mishawn Dunn  
September 10, 2006



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